UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,103	01/17/2002	Akira Date	500.37453CX3	6766

20457 7590 06/07/2007

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

EXAMINER	
JONES, HEATHER RAE	

ART UNIT	PAPER NUMBER
2621	

NOTIFICATION DATE	DELIVERY MODE
06/07/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

officeaction@antonelli.com
dprater@antonelli.com
tsampson@antonelli.com

Office Action Summary	Application No.	Applicant(s)	
	10/047,103	DATE ET AL.	
	Examiner	Art Unit	
	Heather R. Jones	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 5-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 5-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/369,401.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/13/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed March 13, 2007 have been fully considered but they are not persuasive. However, a more detailed explanation about the double patenting rejections with applications will be given below.

2. Applicant's arguments with respect to claims 1, 2, and 5-7 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2, and 5-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over

claims 1-3 of copending Application No. 10/192,696. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in Application 10/192,696 encompass the claims in this case. The claims in Application 10/192,696 are claiming an apparatus for recording on a storage medium and this application is claiming the method for recording on that storage medium. Furthermore, if a patent were issued on this application one skilled in the art would recognize that it covers the claimed subject matter of Application 10/192,696. Therefore, the office cannot issue this patent without a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 7 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/192,717. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim in Application 10/192,717 encompasses the claim in this case. The claim in this case is claiming an apparatus for recording on a storage medium and the claim in Application 10/192,717 is claiming that storage medium. Furthermore, if a patent were issued on this application one skilled in the art would recognize that it covers the claimed subject matter of Application 10/192,717. Therefore, the office cannot issue this patent without a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 7 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/192,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim in Application 10/192,652 encompasses the claim in this case. The claim in this case is claiming an apparatus for recording on a storage medium and the claim in Application 10/192,652 is claiming an apparatus for playing back that storage medium. It is well known to have an apparatus that records and playbacks the same storage medium. Furthermore, if a patent were issued on this application one skilled in the art would recognize that it covers the claimed subject matter of Application 10/192,652. Therefore, the office cannot issue this patent without a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Miike et al. (U.S. Patent 5,787,814).

Regarding claim 7, Miike et al. discloses a method of recording still picture data and still picture group management information for managing N still pictures data as a still picture group onto a storage medium, where said N is an integer number equal to or greater than one, comprising the steps of: recording a first recording time at which the still picture data in the still picture group was recorded first and a last recording time at which the still picture data in the still picture group was recorded last in the still picture group management information (Figs. 2, 95, and 110-113; col. 12, lines 49-57; col. 13, lines 17-20; col. 47, lines 33-37; col. 49, line 59 - col. 50, line 39).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miike et al. (U.S. Patent 5,787,414) in view of Gagne (U.S. Patent Application Publication 2002/0023103).

Regarding claim **1**, Miike et al. discloses a method for recording still picture data and still picture group management information for managing N still picture data as a still picture group onto a storage medium, where N is an integer number equal to or larger than one, wherein the still picture

group management information includes a first recording time at which the still picture data in the still picture group was recorded first and a last recording time at which the still picture data in the still picture group was recorded last (Figs. 2, 95, and 110-113; col. 12, lines 49-57; col. 13, lines 17-20; col. 47, lines 33-37; col. 49, line 59 - col. 50, line 39). However, Miike et al. does not disclose the details of determining the first and last recording times at which the still picture data in the still picture group was recorded. Therefore, Miike et al. fails to disclose a method for comparing a recording time of the still picture data with the first recording times stored in the still picture group management information corresponding to the still picture group belonging to the still picture data and means, if the recording time is later than the last recording time, for replacing the content of the last recording time by the recording time and recording thereof.

Referring to the Gagne reference, Gagne discloses a method for recording wherein the management information is updated after editing the group of pictures by either adding or removing pictures, comprising the steps of: comparing a recording time of the still picture data with the first recording times stored in the still picture group management information corresponding to the still picture group belonging to the still picture data and if the recording time is later than the last recording time replacing the content of the last recording time by the recording time and recording thereof (paragraphs [0039], [0061], and [0080] – start and end times are updated). Gagne et al. discusses this invention according with the respect

to movies, however it would apply for still pictures as well because movies are made up of a bunch of still pictures put together.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teaching of comparing and replacing times as needed in the management information as taught by Gagne with the apparatus as disclosed by Miike et al. in order to provide Miike et al. with a way to determine the first and last record times corresponding to the first and last still picture taken in the still picture group to update the management information.

Regarding claim **2**, Miike et al. in view of Gagne discloses all the limitations as previously discussed with respect to claim 1 as well as further disclosing comparing a recording time of the still picture data with the last recording times stored in the still picture group management information corresponding to the still picture group belonging to the still picture data; and if the recording time is later than the last recording time, the content of the last recording times is replaced by the recording time and recorded (Gagne: paragraphs [0039], [0061], and [0080] – start and end times are updated).

Regarding claims **5** and **6**, these are computer-readable storage medium claims corresponding to the method claims 1 and 2. Therefore, claims 5 and 6 are analyzed and rejected as previously discussed with respect to claims 1 and 2. Furthermore, Gagne discloses that the

computer system has an editing program it uses to edit the picture data (paragraph [0056]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather R. Jones whose telephone number is 571-272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heather R Jones
Examiner
Art Unit 2621

HRJ
May 22, 2007

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600